

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hisashi Tsukamoto et al.

Serial No: 10/666,873

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY
CONSTRUCTION AND METHOD OF
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF

I. **REAL PARTY IN INTEREST**

The real party in interest is Quallion LLC the assignee of the above referenced application.

II. RELATED APPEALS AND INTERFERENCES

This Application is a Divisional of U.S. Patent Application serial number U.S. Patent Application Serial No. 10/167,688, now U.S. Patent No. 6,670,071. U.S. Patent Application serial number 10/666,790 is also a Divisional of U.S. Patent Application Serial No. 10/167,688. In U.S. Patent Application serial number 10/666,790, a Notice of Appeal was filed on September 5, 2007. The associated Appeals Brief has not yet been filed.

U.S. Patent Application serial number 10/665,440 is also a Divisional of U.S. Patent Application Serial No. 10/167,688. In U.S. Patent Application serial number 10/665,440, a Notice of Appeal and a Pre-Appeal Brief Request for Review was filed on June 27, 2007. The associated Appeals Brief was filed on September 25, 2007.

U.S. Patent Application serial number 10/666,861 is a Continuation of U.S. Patent Application Serial No. 10/167,688. In U.S. Patent Application serial number 10/666,861, a Notice of Appeal was filed on June 14, 2007. The associated Appeals Brief has not yet been filed.

III. STATUS OF CLAIMS

The application under appeal includes pending claims 39-41 and 71-78 are pending examination. Claims 39-41 and 71-78 stand rejected for **statutory** double patenting.

IV. STATUS OF AMENDMENTS

An Amendment submitted on **January 3, 2007** amended claims 39 and 79. The amendments were entered and a Final Office Action was mailed on March 12, 2007 (pending Office Action). This Appeal Brief is submitted in response to the pending Office Action.

In accordance with 37CFR§1.116(b), an amendment is submitted with this Appeal Brief. This amendment cancels claims 79, and 80 in accordance with 37CFR§1.116(b)(1).

V. SUMMARY OF CLAIMED SUBJECT MATTER

In accordance with 37 CFR § 41.37c(1)(v), Appellants provide a brief summary of each independent claim involved in the appeal, where each summary refers to the specification by page and line number and to the drawings by reference number. Appellants note that the citations in this "Summary of claimed subject matter" are provided to identify some portions of the specification related to the particular claims. In the interest of brevity, each claim summary does not necessarily include all references to all relevant portions of the specification and drawings. Accordingly, omission of any reference to the specification or to the drawings should not be construed in any way as an intent to relinquish claim scope, or as an implication or statement regarding the conformance with 35 U.S.C. §112. Appellants respectfully submit that the claims should not be construed as being limited to the embodiments cited in the claim summary, and further submit that other embodiments, as well as the Doctrine of Equivalents, may apply in determining claim scope.

Summary of Independent Claim 39

Claim 39 is the only independent claim in the pending claims. Claim 39 is directed to a method of constructing an electrode assembly. The method includes positioning a mandrel on a pin (Figure 6-9 and page 7, line 33-34) such that a portion of a first electrode strip is positioned between the mandrel and the pin (Figure 6-8 and page 7, line 33-34). The method also includes winding the first electrode strip together with a second electrode strip so as to form a spiral roll (Figure 11 and page 9, lines 19-22). The spiral roll is formed after positioning the mandrel on the pin (Figure 11 and page 9, lines 19-22).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Rejection of Claims 39-41 and 71-78 under 35 USC §101 for statutory double patenting.

VII. ARGUMENT

1. Rejection of Claims 39-41 and 71-78 under 35 USC §101 for statutory double patenting.

All of the pending claims stand rejected under 35 USC §101 for statutory double patenting in view of the claims (cited claims) in U.S. Patent Application serial number 10/666,860 (the Cited Application). This rejection is for **statutory double patenting** as opposed to obviousness-type double patenting. Accordingly, this rejection requires that “the ‘scope’ of the inventions claimed is identical” (Examiner note 1 under MPEP §804(II)(A)). As a result, in order for the statutory double patenting rejection to be properly supported, at least one of the pending claims must have the “identical” scope with at least one of the cited claims.

An embodiment can infringe the cited claims without infringing the pending claims

MPEP §804 provides the following test for determining when statutory double patenting exists:

Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

Since there is an embodiment of the invention that infringes the cited claims but not any of the pending claims, MPEP §804 shows that the pending claims and the cited claims are not claiming identical subject matter and that statutory double patenting does not exist.

Claim 20 of the Cited Application recites “connecting a first end of a first

electrode strip to a pin.” Since claim 20 is the only independent claim in the Cited Application, all of the claims in the Cited Application (the cited claims) include this limitation. None of pending claims include this limitation. Further, the pending claims all recite that “a portion of a first electrode strip is positioned between the mandrel and the pin.” Since it is possible for the first end of a first electrode strip to be connected to the pin without being positioned between the pin and the mandrel, an embodiment of the invention can infringe the cited claims without infringing the pending claims. As a result, the pending claims are directed to a different invention than the cited claims. For this reason alone, the rejection for statutory double patenting should be withdrawn.

Prior Office Actions Establish that the Cited Claims are Patentably Distinct from the Pending Claims

There are additional features that distinguish the pending claims from the cited claims. Claim 20 in the Cited Application recites that that “at least a portion of the pin (is) within the spiral roll.” Since claim 20 is the only independent claim in the Cited Application, all of the cited claims include this limitation. In contrast, none of the pending claims includes this limitation.

The prosecution history shows that the phrase “at least a portion of the pin within the spiral roll” makes the pending claims “patentably distinct” from the cited claims. Further, the “patentably distinct” standard is actually the standard for a double patenting rejection rather than for the current statutory double patenting rejection. Since the pending claims and the cited claims are patentably distinct, the pending claims do not even properly support an obviousness-type double patenting rejection. Since the pending claims do not even properly support an obviousness type double patenting rejection, the pending claims cannot properly support the narrower statutory double patenting rejection.

The pending application and the cited application are each a Divisional of U.S. Patent Applications serial number 10/167,688 (now U.S. Patent number 6,670,071, the parent case). The Office Action mailed on June 3, 2003 in the parent case includes a Restriction Requirement that relies on the following argument:

This application contains claims directed to the following **patentably distinct** species of the claimed invention.

III-1, Claims 20-28, drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll having **at least a portion of the pin within the spiral roll**.

III-2, Claims 39-42 drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll. (Emphasis added)

Importantly, the language used to distinguish the group III-1 claims from the group III-2 is identical with the exception of the highlighted phrase “having **at least a portion of the pin within the spiral roll**” being present in the group III-1 claims. Since the above citation is the only argument in the June 3, 2003 Office Action explaining why the group III-1 and III-2 claims are patentably distinct, the June 3, 2003 Office Action is arguing that the presence of this phrase in the group III-1 claims makes these claims “patentably distinct” from the group III-2 claims. As a result, this Office Action asserts that the presence of this phrase in one claim makes that claim patentably distinct over a claim without this phrase.

While the above citation is extracted from an Office Action mailed on June 3, 2003, the Examiner made the same argument as recently as October of 2006, less than one year ago. For instance, this exact same argument was repeated in an Office Action mailed in prosecution of the pending application on **October 20**,

2006. The Applicant has not set forth the more recent citation here since the above citation is repeated verbatim in the October 20, 2006 Office Action. As a result, the prosecution history twice asserts that the phrase “at least a portion of the pin within the spiral roll” in one claim is enough to make that claim patentably distinct from a claim without that limitation.

Despite making the above argument twice, the Office Action is now arguing that this phrase is not sufficient to make claims patentably distinct. Accordingly, the pending Office Action is inconsistently applying the “patentably distinct” standard. For instance, a very narrow standard is being applied when considering restriction requirements but a very broad standard is being applied when considering double patenting. The variation in the standard being applied becomes even more apparent when we recognize that the pending rejection is a STATUTORY double patenting rejection rather than an obviousness-type double patenting rejection. Because a statutory double patenting rejection requires that the allegedly conflicting claims have **identical** scope, the pending Office Action is effectively arguing that the pending claims and cited claims have identical scope. As a result, the pending Office Action is now arguing that claims that recite “at least a portion of the pin within the spiral roll” have identical scope with claims that do not recite this limitation. Accordingly, the pending Office Action is effectively arguing that a claim limitation that as of **October 20, 2006 was significant enough to make claims patentably distinct is now so minimal in effect that a claim with that same limitation has the identical scope as a claim without that limitation.** However, since the standards for patentability are defined, the phrase “patentably distinct” should not be applied with this degree of inconsistency.

Since the prosecution history has twice required restriction based on the argument that the language of “having at least a portion of the pin within the spiral

roll” in one claim makes that claim patentably distinct from a claim without that limitation, the phrase “patentably distinct” should be consistent with its use in both the parent application and in the Office Action mailed October 20, 2006. When the phrase “patentably distinct” is applied consistently, the use of the phrase “having at least a portion of the pin within the spiral roll” in the cited claims makes the pending claims patentably distinct from the cited claims.

Importantly, the “patentably distinct” standard discussed above is actually the standard for obviousness-type double patenting rather than statutory double patenting. However, the standard for the current STATUTORY double patenting rejection is much more difficult to satisfy than the standard for obviousness-type double patenting. The following text from MPEP§804 distinguishes the different standards:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not **patentably distinct** from the reference claim(s)...

Accordingly, the MPEP requires that allegedly conflicting claims have identical scope in order to support a statutory double patenting rejection (Examiner note 1 under MPEP §804(II)(A)) **but only requires** that the claims are not “patentably distinct” in order to properly support an obviousness-type double patenting rejection. Since the prosecution history establishes that the pending claims and the cited claims are patentably distinct, the prosecution history establishes that an obviousness-type double patenting rejection is not even properly supported. Further, since the standard for a proper statutory double patenting rejection is more difficult to satisfy than the standard for an obviousness-type double patenting rejection, there is no reasonable argument that claims that cannot properly support an obviousness-type double patenting rejection support a rejection for statutory

double patenting. For this reason alone, the rejection for statutory double patenting should be withdrawn.


The Pending Office Action Has not Addressed the Above Arguments

Additionally, the pending Office Action has not addressed the above arguments with respect to the pending claims. Accordingly, the Applicant is unable to address any pending arguments regarding these claims.

CONCLUSION

Since an embodiment of the invention can infringe the cited claims without infringing the pending claims, the cited claims are directed to a different invention than the cited claims. For this reason alone, the statutory double patenting rejection should be withdrawn. Additionally, the prosecution history shows that the pending claims do not even properly support an obviousness-type double patenting rejection. Since the pending claims do not even properly support an obviousness-type double patenting rejection, the pending claims cannot properly support the current STATUTORY double patenting rejection. For this reason alone, the statutory double patenting rejection should be withdrawn. However, when the above arguments are considered together, the argument for the withdrawal of the statutory double patenting rejection becomes even stronger. As a result, the statutory double patenting rejection should be withdrawn.

Respectfully submitted



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VIII. CLAIMS APPENDIX

1.-38. (canceled)

39. (previously presented) A method of constructing an electrode assembly including:

positioning a mandrel on a pin such that a portion of a first electrode strip is positioned between the mandrel and the pin; and

winding the first electrode strip together with a second electrode strip so as to form a spiral roll, the spiral roll being formed after positioning the mandrel on the pin.

40. (previously presented) The method of claim 39, further comprising:

crimping the mandrel to the pin.

41. (previously presented) The method of claim 39, further comprising:

welding the mandrel to the pin.

42.-70. (canceled)

71. (previously presented) The method of claim 39, wherein the spiral roll is formed such that a portion of the pin is positioned in the spiral roll and another portion of the pin is positioned outside of the spiral roll.

72. (previously presented) The method of claim 39, wherein the mandrel is positioned on the pin such that the mandrel is in electrical communication with the pin.

73. (previously presented) The method of claim 39, wherein an end cap is positioned on the pin, the end cap being configured to serve as a cap for a battery case, the end cap including an electrical insulator, and the pin extending through the insulator.

74. (previously presented) The method of claim 39, wherein the end cap includes a conductive

member surrounding the insulator.

75. (previously presented) The method of claim 39, wherein the mandrel includes a tube.

76. (previously presented) The method of claim 75, wherein positioning the mandrel on the pin includes positioning the pin in an interior of the tube.

77. (previously presented) The method of claim 39, wherein the mandrel has a c-shaped cross-section.

78. (previously presented) The method of claim 39, wherein positioning the mandrel on the pin includes sliding the mandrel onto the pin.

79.-80. (canceled)

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.